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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,793	01/11/2002	Victor Klimyuk	ICON-002	4086

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EXAMINER

MEHTA, ASHWIN D

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/030,793

Applicant(s)

KLIMYUK ET AL.

Examiner

Ashwin Mehta

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

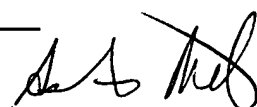
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 2, 4-9, 11-16, 18, 19, 36-41, 43, 44.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
ASHWIN D. MEHTA, PH.D.  
PRIMARY EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicants' response has overcome the rejections under 35 U.S.C. 112, 2nd paragraph; the rejection of product claims 20-35 and 42 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, for lacking written description; the scope of enablement rejection regarding the issue of the type of radiation used with the claimed methods to produce chromosome fragments, and the issue regarding the enablement of the product claims.

Continuation of 11. does NOT place the application in condition for allowance because: the reply does not overcome the rejection of claim 19 under 35 U.S.C. 112, 1st paragraph, for lack of enablement. The claim was found to lack enablement because it encompassed making chromosome fragments in whole plants. Applicants argue that the prior art cited by the Examiner illustrates regeneration of plants from irradiated protoplasts (response, paragraph bridging pages 8-9). However, regeneration of plants from irradiated protoplasts is not the issue. Rather, the issue is that the claim encompasses producing chromosome fragments in whole plants by irradiating whole plants. The amended claim in part (b) now indicates that protoplasts of the transformed plants of part (a) are irradiated. However, part (a) does not mention any protoplasts, and part (c) mentions that the chromosome fragments are in plant species, not protoplasts. The rejection is maintained, as the new indefinite issue does not exactly make it clear whether protoplasts are formed, and what is being irradiated.

Applicants' reply also does not overcome the rejection under 35 U.S.C. 103(a), which also applies to new claims 43 and 44. Applicants attempt to disparage the accomplishments of Famelaer et al. by arguing that the teachings merely experiment with the possibility of transferring non-exogenous DNA via fusion of irradiated and non-irradiated protoplasts. Applicants also allege that improper hindsight was used (response, page 10, 1<sup>st</sup> full paragraph to page 11, 2<sup>nd</sup> full paragraph). However, Famelaer et al. did not "merely experiment" with a "possibility", they were successful. The only difference between Famelaer and the claims is the presence of transgenic nucleic acid in the chromosomes of the protoplasts to be irradiated. The presence of this transgenic DNA does not have any effect on any method step taught by Famelaer et al., and one of ordinary skill in the art would have had a reasonable expectation of success.

Claim 4 is now indefinite, as it is dependent on cancelled claim 3. Also note that claim 19 lacks antecedent basis for "the protoplasts of (a)" in part (b). Claim 43 also contains indefinite issues, in that it is missing the step of how the chromosome fragments are produced. The claim is also indefinite in the recitation, of part (e), "fusing protoplasts of from the cells of (d)". Part (d) does not mention any protoplasts.